AMENDMENTS to the DRAWINGS

No amendments or changes to the Drawings are proposed.

REMARKS

Nature of Amendment

In the present amendment, we have amended claims directed towards method embodiments of our invention, and we have cancelled all other pending claims from further consideration in this application. We are not conceding that the subject matter encompassed by the cancelled claims prior to this Amendment are not patentable over the art cited by the Examiner. Amendment and cancellation of these claims are made solely to facilitate expeditious prosecution of at least a portion of allowable subject matter in this application. We respectfully reserve the right to pursue claims, including the subject matter encompassed by the cancelled claims, as present prior to this Amendment and additional claims in one or more continuing applications.

Amendment in Response to BPAI Decision

We respectfully disagree with the Board's interpretation that our claims necessarily including downloading non-essential objects when a battery condition is low, because we believe that our claim phrase *"selecting only non-essential web objects"* followed by the claim phrase *"transmitting said selected web objects"* literally means "*transmitting only non-essential web objects"* through the antecedent operation of the term "said".

As we best understand the Board's decision, the claims would have been allowable *if* this limitation were actually in the claims, but because the Board interpreted the claims not to include this limitation, the rejections were sustained. The Board also questioned the definition to be used of the term "essential", whether or not it should be given its plain meaning, or should be interpreted as meaning "non-advertisement". The Board, for the purposes of its decision, selected the former.

In response, we are hereby amending the claims (a) to exchange the term *essential* with *non-advertisement*, (b) to exchange the term *non-essential* with *advertisement*, and (c) to specify *restriction* of advertisement web objects from download to the client device when battery power level is low. We believe that the Board indicated that our arguments and disclosure supported this claim scope, although it was not, in their opinion, actually claimed. For reference, we believe this amendment is supported in particular by our disclosure at ¶0021, ¶0036, and ¶0042.

Request for Explicit Determination of Ordinary Skill Level

The Court in *KSR Int'l v. Teleflex Inc., et al.,* (U.S. Supreme Court, April 30, 2007) ("KSR") reiterated the importance of "resolving" the ordinary skill level using objective analysis when applying 35 U.S.C. §103(a) in a rejection, as set earlier forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 - 18 ("Graham"). The Court in *KSR* clearly stated the need for explicit analysis (our emphasis added):

> ". . . To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. **To facilitate review, this analysis should be made explicit**. . . . "

The reasons for rejection under 35 U.S.C. §103(a) as set forth in the Office Action did not include explicit determination of what was the ordinary skill level in the art at the time of our invention. This explicit determination by objective analysis is a requirement of the Examiner. ("Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*:, Fed. Reg., Vol. 72, No. 195, October 10, 2007).

We believe that a *prima facie* case of obviousness cannot be established without completing all of the *Graham* inquiries, including determining ordinary skill level. We believe the Supreme Court has stated that this determination should be explicit, rather than the tradition of presuming a skill level based upon the skill level evident in one or more cited references. To presume a skill level simply based upon the cited references would be using an *implied* skill level, not and explicitly determined skill level:

> **implied**
> *adj., adv.* referring to circumstances, conduct or statements of one or both parties which substitute for explicit language to prove authority to act, warranty, promise, trust, agreement, consent or easement, among other things. Thus circumstances "imply" something rather than spell it out. *(Source: http://dictionary.law.com/default2.asp?selected=903&bold =explicit on Aug. 28, 2008)*

We also respectfully propose that to rely upon implied skill levels without consideration of factors such as those suggested by the Court in *Environmental Designs, Ltd. v. Union Oil* (713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983)) and in *Bausch & Lomb, Inc. v.*

Barnes-Hind/Hydrocurve, Inc. (796 F.2d 443, 449-450, 230 USPQ 416, 420 (Fed. Cir. 1986)) would be failing to provide any *analysis* subject for review as required by the Supreme Court in *KSR*.

For these reasons, we respectfully request an explicit determination of the ordinary skill level at the time of our invention if a rejection any claim is rejected under 35 U.S.C. §103(a).

Request for Indication of Allowable Subject Matter

We believe we have responded to all grounds of rejection and objection, but if the Examiner disagrees, we would appreciate the opportunity to supplement our reply.

We believe the present amendment places the claims in condition for allowance. If, for any reason, it is believed that the claims are not in a condition for allowance, we respectfully request constructive recommendations per MPEP 707.07(j) II which would place the claims in condition for allowance without need for further proceedings. We will respond promptly to any Examiner-initiated interviews or to consider any proposed examiner amendments.

Respectfully,

/ Robert Frantz /

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